

REMARKS

Claims 1-9, 11-14 and 16-22 are pending. Claims 10 and 15 have been canceled. Claims 5-6 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the following remarks.

Claims 1, 2, 8, 9 and 21 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,384,174, Ward et al. (“Ward”) in view of U.S. Patent No. 5,212,002, Madrzak et al. (“Madrzak”) and U.S. Patent No. 5,806,271, Van Somern et al. (“Van Somern”). Claims 3, 4, 13, 14, 17-20 and 22 were rejected under 35 USC 103(a) as being unpatentable over Ward, Madrzak, and Van Somern, further in view of U.S. Patent No. 5,008,110, Benecke et al. (“Benecke”). Claims 7, 11, 12 and 16 were rejected under 35 USC 103(a) as being unpatentable over Ward, Madrzak, Van Someren, and Benecke, further in view of U.S. Patent No. 5,376,418, Rogers et al. (“Rogers”).

The rejections are respectfully traversed for reasons including the following, which are presented by way of example.

The examiner admits that Ward fails to teach or suggest “the first and second sides do not touch one another and the laminate sheet is disposed in a longitudinally rolled-up form, the void existing between the first and second portions and wherein the laminate sheet is in a roll so that the void between the first and second portions acts as a spacer and maintains surface smoothness”. The examiner cites Madrzak as disclosing “the first and second sides do not touch one another (Figure 4 #8 and 8’) and the laminate sheet is disposed in a longitudinally rolled-up form, the void existing between the first and second portions (Column 2, lines 2-3) for the purpose of keeping the thickness at the joint area low (Column 3, lines 5 – 8)”. Then, the examiner cites Van Someren as disclosing that “the laminate sheet is in a roll so that the void

between the first and second portions acts as a spacer and maintains surface smoothness (Figures 4-67, #14) for the purpose of keeping the base material shaped away from a surface (Column 5, lines 6-17).”

Van Someren is non-analogous art and accordingly fails to remedy the deficiencies of Ward and Madrzak. In order to be analogous, “a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). MPEP 2141.01(a). Van Someren is not in the field of applicant's endeavor. Moreover, Van Someren is not reasonably pertinent to the particular problem with which the applicant was concerned.

Here, the applicants' claims relate to the art of surface smoothness in adhesive laminates used for, e.g., an optical disk cover or anti-reflection film on a PDA, where there is a principally used portion which is softer than the other layers. The specification points out the particular problem:

“when a laminate sheet is wound into a roll, a winding pressure is applied onto the laminate sheet. Therefore, the adhesive layer, which is softer than the other layers present in the laminate sheet, is deformed with the elapse of time due to the action of the winding pressure, and the adhesive layer is in a so-called ‘orange peel’ state ... Moreover, in some cases, foreign substances (of which diameter is in general ranges from 5 to 50 μm) such as fine dust are caught between the layers of the wound laminate sheet, when winding the sheet into a roll. In case of winding a laminate sheet into a roll while catching such foreign substances between the rolled layers, thereof, the base material and the adhesive layer of the laminate sheet are thus locally deformed by the presence of such foreign substances.” (Page 1, line 16 to page 2, line 12.)

In comparison, Van Someren is directed to the problem when painting or varnishing that “masking tape is often unable to provide a sufficient seal along the boundary line between adjacent surfaces. Even with the slightest texture, such as old paint, marring, or nicks, the masking tape fails to adequately fill voids caused by the textured surface. Thus, the finishing

material seeps under the masking tape onto the adjacent surface.” (Abstract.) Element #14 is cited as being particularly relevant to creating a void so as to maintain surface smoothness for the purpose of keeping the base material shaped away from a surface. To the contrary, the purpose of the strip (14) is “to prevent penetration of paint onto wall surface 36 via either spotting along boundary 46 or seeping between flexible sheet 12 and the wall surface” (col. 4, lines 29-31). That is, Van Someren deals with paint seepage. Furthermore, the laminate sheet of Van Someren is not an adhesive product (Col. 4, lines 49-61).

Consequently, Van Someren’s field is completely different from the applicants’ field of endeavor. Moreover, Van Someren is not even remotely pertinent to the particular problem with which the applicants were concerned.

A person having ordinary skill in the art of adhesive laminates for optical disk covers or PDA films would not reasonably have expected to solve the problem of keeping adhesive layers smooth when wound, by considering a reference dealing with the problem of paint seepage.

Ward, Madrzak, Van Someren, Benecke, and Rogers fail to teach or suggest, for example, these elements recited in the independent claims. It is respectfully submitted therefore that the independent claims are patentable over the other references of record.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1 and 3, but also because of additional features they recite in combination.

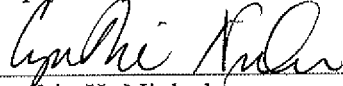
The applicants respectfully submit that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,


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